

REMARKS

Overview

In the Final Office Action ("Action") under reply, claims 7, 9-12, 15-18, 20-27, and 30-33 were examined, claims 1-6 having been previously withdrawn and claims 8, 13, 14, 19, 28, and 29 having been previously canceled. Applicants acknowledge with appreciation the Examiner's recognition of claims 20 and 21 as allowable but for their dependency on a rejected base claim. Claims 7, 9-12, 15-18, 22-27, and 30-33 are rejected under 35 U.S.C. §102(b) as anticipated by Urry et al. (1968) *J. Org. Chem.* 33(6):2302-2310 ("Urry").

The rejections and objections are overcome in part by the amendments made herein, and are otherwise traversed for at least the reasons set forth below.

Claim amendments

With the amendments made herein, claim 7 has been amended to remove the term "isobutylene." Claim 22 has been amended to indicate that the methyl group attached to the olefinic carbon is substituted. No new matter has been added by these amendments.

Except for a different proviso at the end of each claim, new claims 34 and 37 are identical to claim 22. Claim 34 specifies that R⁶ and R⁷ are not the same group such that the fluorinated carbonyl compound is asymmetric. Support for new claim 34 is found, for example, in paragraph [0055] of the original specification. Claim 37 specifies that R⁶ and R⁷ are taken together to form a cycle. Support for new claim 35 is found, for example, in original claim 13. Dependent claims 35-36 and 38-39 find support in original claims 25 and 27. No new matter is added by these claims.

Rejection under 35 U.S.C. §102(b)

Claims 7, 9-12, 15-18, 22-27, and 30-33 stand rejected under 35 U.S.C. §102(b) as anticipated by Urry. This rejection is traversed.

The present claims are directed to a method for synthesizing an alkene fluoroalkanol, comprising contacting an olefinic reactant with a fluorinated ketone. Specifically, the independent claims include the following limitations:

Claim 8 requires that when the olefinic reactant is not pinene, butenyl methyl ether, isopropenyl methyl ether, *exo*-2-methylene norbornane, 5-vinyl-2-

norbornene, *exo*-methylene cyclopentane, or *exo*-methylene cyclohexane, the fluorinated ketone is asymmetric or cyclic.

Claim 22 requires that olefinic reactant is directly substituted with a substituted methyl group.

New claim 34 (not part of the rejected claims) requires that the fluorinated ketone is asymmetric.

New claim 37 (not part of the rejected claims) requires that the fluorinated ketone is cyclic.

The Action cites a reaction between isobutylene and perfluoroacetone (Urry, page 2302). This reaction does not, however, satisfy the limitations of the independent claims. Regarding claim 8, since the olefinic reactant (i.e., isobutylene) is not selected from the choices in the claim, the claim requires that the fluorinated ketone is asymmetric or cyclic. The fluorinated ketone in the cited reaction (i.e., perfluoroacetone) is *not* asymmetric or cyclic, and the reaction therefore does not satisfy the limitations of the claim. Regarding claim 22, isobutylene is an olefinic reactant that contains an *unsubstituted* methyl group directly attached to the olefin, and therefore does not satisfy the limitations of the claim. Although claim 34 is not part of the rejected claims, applicants note that the claim is not anticipated by the cited reaction because perfluoroacetone is not an asymmetric fluorinated ketone. Similarly, although claim 37 is not part of the rejected claims, applicants note that the claim is not anticipated by the cited reaction because perfluoroacetone is not a cyclic fluorinated ketone.

The Action also cites a reaction between isobutylene and 1,3-dichloro-1,1,3,3-tetrafluoropropanone (Urry, page 2309). This reaction does not, however, satisfy the limitations of the independent claims. Regarding claim 8, since the olefinic reactant (i.e., isobutylene) is not selected from the choices in the claim, the claim requires that the fluorinated ketone is asymmetric or cyclic. The fluorinated ketone in the cited reaction (i.e., 1,3-dichloro-1,1,3,3-tetrafluoropropanone) is *not* asymmetric or cyclic, and the reaction therefore does not satisfy the limitations of the claim. Regarding claim 22, isobutylene is an olefinic reactant that contains an *unsubstituted* methyl group directly attached to the olefin, and therefore does not satisfy the limitations of the claim. Although claim 34 is not part of the rejected claims, applicants note that the claim is not anticipated by the cited reaction because 1,3-dichloro-1,1,3,3-tetrafluoropropanone is not an asymmetric fluorinated ketone. Similarly, although claim 37 is not

part of the rejected claims, applicants note that the claim is not anticipated by the cited reaction because 1,3-dichloro-1,1,3,3-tetrafluoropropanone is not a cyclic fluorinated ketone.

In light of the above comments, applicants respectfully request withdrawal of the rejection under 35 U.S.C. §102(b).

Claim objections

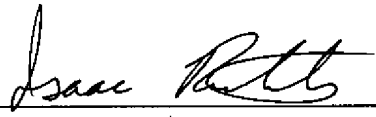
Claims 20 and 21 are objected to as being dependent upon a rejected base claim. In light of the amendments and arguments set forth herein, applicants submit that these claims are no longer dependent from a rejected base claim, and respectfully request withdrawal of the objections to the claims.

CONCLUSION

Applicants submit that the claims of the application are in condition for allowance. Applicants respectfully request withdrawal of the rejections, and prompt issuance of a notice of allowance. If the Examiner has any questions concerning this communication, or would like to discuss the application, the art, or other pertinent matters, a telephone call to the undersigned would be welcomed.

Respectfully submitted,

By:


Isaac M. Rutenberg
Registration No. 57,419
c/o MINTZ LEVIN
1400 Page Mill Road
Palo Alto, California 94304-1124
(650) 251-7700 Telephone
(650) 251-7739 Facsimile
Customer No. 23980